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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 09/676,319   | 09/29/2000  | Emie F. Brickell     | 10559-329001/P9832  | 1992             |
| 20985  | 7590        | 02/01/2008           | EXAMINER            |                  |
| FISH & RICHARDSON, PC<br>P.O. BOX 1022<br>MINNEAPOLIS, MN 55440-1022 |             |                      | HENNING, MATTHEW T  |                  |
|  |             | ART UNIT             | PAPER NUMBER        |                  |
|  |             | 2131                 |                     |                  |
|  |             | MAIL DATE            | DELIVERY MODE       |                  |
|  |             | 02/01/2008           | PAPER               |                  |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

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|                              |                    |                 |
|------------------------------|--------------------|-----------------|
| <b>Office Action Summary</b> | Application No.    | Applicant(s)    |
|                              | 09/676,319         | BRICKELL ET AL. |
|                              | Examiner           | Art Unit        |
|                              | Matthew T. Henning | 2131            |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 09 January 2008.
- 2a) This action is FINAL.                            2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 42-46,48-54,56,58-62,64-66,69 and 70 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 42-46,48-54,56,58-62,64-66,69 and 70 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 29 September 2000 is/are: a) accepted or b) objected to by the Examiner. Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a). Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All    b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 11/15/2007.
- 4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) Notice of Informal Patent Application
- 6) Other: \_\_\_\_\_.

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1                   This action is in response to the communication filed on 1/09/2008.

2                   **DETAILED ACTION**

3                   *Response to Arguments*

4                   Applicant's arguments with respect to claims 42-46, 48-54, 56, 58-62, 64-66, and 69-70  
5                   have been considered but are moot in view of the new ground(s) of rejection.

6                   The examiner notes that the objections to the specification, and claims, as well as the  
7                   rejection of claims 48, 56, and 64, were previously presented, and have not been addressed by  
8                   the applicants. As such, the examiner has maintained these objections and rejections.

9                   All objections and rejections not presented below have been withdrawn.

10                  Claims 42-46, 48-54, 56, 58-62, 64-66, and 69-70 have been examined.

11                  *Information Disclosure Statement*

12                  The information disclosure statement (IDS) submitted on 11/15/2007 is in compliance  
13                  with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being  
14                  considered by the examiner.

15                  *Specification*

16                  The specification is objected to as failing to provide proper antecedent basis for the  
17                  claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the  
18                  following is required: In this case, the applicant has not pointed out support for a second relying  
19                  party, as recited in claims 48, 56, and 64. Further, the examiner has been unable to find support  
20                  for this limitation in the specification as originally filed. See the rejection of claims 48, 56, and  
21                  64 under 35 USC 112 1<sup>st</sup> Paragraph below.

22                  *Claim Objections*

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1 Claim 62 is objected to because of the following informalities: Claim 62 recites “the  
2 authentication server” which lacks antecedent basis in the claim. It appears that this should have  
3 been amended to read “the authentication service”, as was done to claims 58-65. Appropriate  
4 correction is required.

## ***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claim 48, 56, and 64 are rejected under 35 U.S.C. 112, first paragraph, as failing to  
y with the written description requirement. The claim(s) contains subject matter which  
t described in the specification in such a way as to reasonably convey to one skilled in the  
t art that the inventor(s), at the time the application was filed, had possession of the  
d invention. In this case, the applicant has not pointed out support for a second relying  
as recited in claims 48, 56, and 64. Further, the examiner has been unable to find support  
s limitation in the specification as originally filed. As such, the claims are rejected for  
to meet the written description requirement of 35 USC 112 1<sup>st</sup> Paragraph. The claims  
een examined in view of the prior art below.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

*A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having*

1     *ordinary skill in the art to which said subject matter pertains. Patentability shall not be*  
2     *negatived by the manner in which the invention was made.*

3

4         Claims 42-46, 48-54, 56, 58-62, 64-66, and 69-70 are rejected under 35 U.S.C. 103(a) as  
5     being unpatentable over Anderson et al. (US Patent Number 6,021,202) hereinafter referred to as  
6     Anderson, and further in view of Saito et al. (US Patent Number 6,275,941) hereinafter referred  
7     to as Saito, and further in view of Joao et al. (US Patent Number 6,047,270) hereinafter referred  
8     to as Joao.

9         Regarding claims 42, 50, and 58, Anderson disclosed a machine-implemented method  
10    (See Anderson Fig. 26) comprising: relying on digital credential information (Signature and  
11    digital certificate) by a relying party (Third 468) wherein the digital credential information is  
12    indicative of a first user being professionally licensed (Doctor 462) but has been received by the  
13    relying party from an unauthorized user (See Anderson Fig. 26 and Col. 39 Line 21 – Col. 40  
14    Line 11 and Col. 27 Paragraph 4 wherein it is implied that not all of the uses of the signature  
15    card are necessarily legitimate and as such it is obvious that an unauthorized user could have  
16    used it to provide the signature credentials); verifying that the digital credential information is  
17    valid using the professional license status information that has been stored for a plurality of users  
18    (See Anderson Col. 11 Paragraph 2); and providing information to the first user, the information  
19    indicative of receipt of valid digital credential information from the relying party (See Anderson  
20    Col. 40 Lines 8-10 and Col. 24 Lines 38-50); wherein the relying party, the unauthorized user,  
21    and the first user are distinct from each other (See Anderson Fig. 26 and Col. 27 Paragraph 4),  
22    but Anderson failed to disclose how to verify the digital credential information, or specifically an  
23    authentication service, which receives the credential information from the relying party, provides  
24    the verification information indicative of a valid professional license status of the first user from

1 to the relying party; or provides, to the first user, the information indicative of receipt of valid  
2 digital credential information from the relying party.

3 Saito teaches a system for verifying digital credential information including digital  
4 certificates of a user (See Saito Fig. 5 and Col. 7 Lines 5-55) involving an authentication service  
5 (authentication server), receiving digital credential information (integrated certificate) associated  
6 with a first user (client) from a relying party (application server) (See Saito Col. 7 Lines 21-24);  
7 verifying the digital credential information associated with the first user to the relying party (See  
8 Saito Col. 7 Lines 25-36); providing verification information associated with the first user to the  
9 relying party (See Saito Col. 7 Lines 36-52); and providing information from the authentication  
10 service to the first user, the information indicative of receiving the digital credential information  
11 associated with the first user from the relying party (See Saito Col. 7 Lines 36 – Col. 8 Line 8).

12 Joao teaches that in a card transaction system, in order to prevent fraudulent use of the  
13 account associated with the card, a central party will verify the status of the account, and if the  
14 account is valid, the central party will transmit a signal, to a cardholder designated in the  
15 account, via telephone, computer, beeper, etc. notifying the cardholder of the transaction, at  
16 which point the cardholder may stop the transaction by transmitting a response to the signal (See  
17 Joao Figs. 3A-3C and Col. 18 Line 60 - Col. 22 Line 56).

18 It would have been obvious to the ordinary person skilled in the art at the time of  
19 invention to employ the teachings of Saito in the network prescription issuing system of  
20 Anderson by utilizing an authentication server as taught by Saito to verify the digital signatures,  
21 digital certificates, and license statuses of Anderson upon the request of one of the relying third

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1 parties. This would have been obvious because one of ordinary skill in the art would have been  
2 motivated to provide means for verifying this data as required by Anderson.

3 It further would have been obvious to the ordinary person skilled in the art at the time of  
4 invention to employ the teachings of Joao in the system of Anderson and Saito by having the  
5 authentication server (central party), upon successfully verifying the status of the license,  
6 sending a signal to the Doctor designated for the account, notifying the Doctor of the transaction,  
7 at which point the Doctor could respond to the signal and prevent the transaction from occurring.  
8 This would have been obvious because the ordinary person skilled in the art would have been  
9 motivated to prevent the fraudulent use of the prescription issuing system of Anderson.

10 Regarding claims 43, 51, and 59, the combination of Anderson, Saito, and Joao disclosed  
11 providing access to an activity log associated with the first user (See Anderson Col. 40 Lines 8-  
12 10 and Col. 24 Lines 38-50 and further see Joao Col. 20 Lines 16-47).

13 Regarding claims 44-45, 52-53, and 60-61, the combination of Anderson, Saito, and Joao  
14 disclosed that the professional license status information comprises registration information  
15 indicative of a professional license registration status with a registration authority (See Anderson  
16 Col 11 Paragraph 2), and the method further comprises, prior to providing the verification  
17 information to the relying party, verifying the registration information with the registration  
18 authority (See Anderson Col. 11 Paragraph 2 and the rejection of claim 42 above).

19 Regarding claims 46, 54, and 62, the combination of Anderson, Saito, and Joao disclosed  
20 storing access information associated with the relying party, the access information including  
21 information indicative of the providing the verification information (See Joao Col. 20 Line 37 -

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1 Col. 21 Line 58); and providing the access information to the relying party (See Joao Col. 20  
2 Line 37 – Col. 21 Line 58).

3 Regarding claims 48, 56, and 64, the combination of Anderson, Saito, and Joao disclosed  
4 providing information indicative of a failure to authenticate the digital credential information  
5 associated with the first user to a second relying party (See Saito Col. 7 Lines 36-38 and  
6 Anderson Fig. 26).

7 Regarding claims 49, and 65, the combination of Anderson, Saito, and Joao disclosed at  
8 least one of the relying party and the authentication service issuing a challenge in response to  
9 receiving digital credential information associated with the first user (See Saito Col. 7 Lines 21-  
10 24).

11 Regarding claim 66, the combination of Anderson, Saito, and Joao disclosed receiving, at  
12 the relying party, the valid digital credential information from an unauthorized user (See  
13 Anderson Col. 27 Paragraph 4 wherein it is implied that not all of the uses of the signature card  
14 are necessarily legitimate and as such it is obvious that an unauthorized user could have used it  
15 to provide the signature credentials).

16 Regarding claim 69, the combination of Anderson, Saito, and Joao disclosed that the  
17 information is provided from the authentication service to the first user in response to the relying  
18 party having received the valid digital credential information from an unauthorized user (See  
19 Anderson Col. 27 Paragraph 4 wherein it is implied that not all of the uses of the signature card  
20 are necessarily legitimate and as such it is obvious that an unauthorized user could have used it  
21 to provide the signature credentials).

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1       Regarding claim 70, the combination of Anderson, Saito, and Joao disclosed a relying  
2       party configured to receive the digital credential information associated with the first user and  
3       relay it to the authentication service (See Saito Col. 7 Lines 10-24 and the rejection of claim 42  
4       above).

## *Conclusion*

Claims 42-46, 48-54, 56, 58-62, 64-66, and 69-70 have been rejected.

Any inquiry concerning this communication or earlier communications from the  
Examiner should be directed to Matthew T. Henning whose telephone number is (571) 272-3790.  
The examiner can normally be reached on M-F 8-4.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ayaz Sheikh can be reached on (571) 272-3795. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

13 Information regarding the status of an application may be obtained from the Patent  
14 Application Information Retrieval (PAIR) system. Status information for published applications  
15 may be obtained from either Private PAIR or Public PAIR. Status information for unpublished  
16 applications is available through Private PAIR only. For more information about the PAIR  
17 system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR  
18 system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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1 /Matthew Henning/  
2 Assistant Examiner  
3 Art Unit 2131  
4 1/29/2008

  
AYAZ SHEIKH  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2100